

REMARKS/ARGUMENTS

The Applicant respectfully requests reconsideration of the present application in light of the amendments above and the following remarks. Claims 1-19 were originally filed in the present application. In response to a Restriction Requirement, Applicant elected claims 1-10 to be prosecuted in the present Application. As a result, claims 11-19 have been withdrawn. By the present Amendment, the Applicant has amended claims 1 and 2 for clarity (although Applicant submits that the amendments do not alter the scope of the claimed invention(s)), placing the claims in condition for allowance. Accordingly, claims 1-10 are presently pending in this Application.

I. INDEFINITENESS OBJECTION UNDER 35 U.S.C. §112

Examiner objected to claims 1-10 as being indefinite for lack of prior antecedent in claims 1 and 2. While Applicant feels that these claims were actually definite in their original form, Applicant has amended claims 1 and 2 for clarity, in an effort to move this application forward to issuance. Accordingly, reconsideration and withdrawal of the objection under 35 U.S.C. §112 is respectfully requested.

II. ANTICIPATION REJECTION UNDER 35 U.S.C. §102

Examiner rejected claims 1,3, and 5-7 under 35 U.S.C. §102(b) as allegedly being anticipated by *Pennig* (U.S. Patent No. 4,988,349). In addition, Examiner rejected claims 1 and 3-5 as allegedly being anticipated by *Weiner* (U.S. Patent No. 6,056,748). A patent claim may only be anticipated, under 35 U.S.C. §102, if a single reference discloses each and every element found in the patent claim. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed. Cir. 1998). Applicant has reviewed both of the cited references and respectfully disagrees with the Examiner's characterization of these claims, as set forth in detail below.

A. Rejection based on *Pennig*

In comparing claim 1 to the cited *Pennig* reference, the Examiner indicates that *Pennig* discloses each and every element of claim 1 of the present application. Applicant, however, would draw the Examiner's attention to the differences between the ball-and-socket connection used in *Pennig* and the coupling assembly described in claim 1 of the present application with reference to the one or more controls. Specifically, claim 1 (in its currently amended form) requires "one or more controls for incremental rotation of the first portion and the second portion relative to each other in the horizontal plane **independent** of rotation in the vertical plane and incremental rotation of the first portion and the second portion relative to each other in the vertical plane **independent** of rotation in the horizontal plane." As is generally explained on pages 1 and 2 of the application specification, the ability to independently control movement in the horizontal and vertical planes allows for incremental adjustments while maintaining the desired torque. In other words, the invention of claim 1 allows doctors to more easily make precise adjustments to the positioning of the device (and the body part to which it is affixed) in one direction (for example the horizontal plane) without fear of losing the current positioning of the device in the other direction (for example the vertical plane).

Pennig does not have such control elements allowing for incremental, independent rotation in either the horizontal or vertical plane. Rather, *Pennig* discloses a ball-and-socket type joint. While a ball-and-socket joint allows great freedom of movement, structurally it does not provide for such incremental, independent position rotations. Rather, when the screw locking the position of the ball in the socket is loosened, the ball becomes freely "movable to all sides." (*Pennig*, col. 2, line 32). In fact, a close examination of the double-ball hinge of *Pennig* reveals that no control elements are disclosed (and certainly, no control elements that provide incremental, independent rotation in separate planes). There is simply a locking mechanism (screw) that may hold the position of the device in place; there is no element which allows a doctor to incrementally control movement in each independent plane.

The requirement for one or more controls providing for independent movement in different planes is not merely a functional statement of limited use (as the Examiner seems to have characterized it). Rather, the control(s) are structural elements, and the movements they provide explain the manner in which the control(s) relate to other structural elements set forth in the claims. Furthermore, independent control is an important distinguishing feature in this field, making the present invention more useful to physicians. As Applicant noted in the specification (pages 1 and 2), there was a longstanding need for this type of ability to make controlled adjustments in different, independent directions. But *Pennig*, like so much of the prior art, is unconcerned with this real-world need.

As *Pennig* does not disclose each and every element of claim 1, it cannot anticipate claim 1. Furthermore, since claims 3 and 5-7 are dependent on claim 1, *Pennig* cannot anticipate these claims either. Accordingly, Applicant requests that the Examiner withdraw the §102 rejection of claims 1, 3, and 5-7 based on *Pennig* and instead recognize these claims as allowable.

B. Rejection based on *Weiner*

In comparing claim 1 to the cited *Weiner* reference, the Examiner indicates that *Weiner* discloses each and every element of claim 1 of the present application. Applicant, however, would draw the Examiner's attention to the differences between the universal joint connection used in *Weiner* and the coupling assembly described in claim 1 of the present application in conjunction with the one or more controls. Specifically, claim 1 (in its currently amended form) requires "one or more controls for incremental rotation of the first portion and the second portion relative to each other in the horizontal plane **independent** of rotation in the vertical plane and incremental rotation of the first portion and the second portion relative to each other in the vertical plane **independent** of rotation in the horizontal plane." As is generally explained on pages 1 and 2 of the application specification, the ability to independently control movement in the horizontal and vertical planes allows for incremental adjustments while maintaining the desired torque. In other words, the invention of claim 1 allows doctors to more easily make

precise adjustments to the positioning of the device (and the body part to which it is affixed) in one direction (for example the horizontal plane) without fear of losing the current positioning of the device in the other direction (for example the vertical plane).

Weiner does not have such control elements allowing for incremental, independent rotation in either the horizontal or vertical plane. Rather, *Weiner* discloses a universal-type joint. (Col. 2, line 66; Col. 3, lines 1-3). A universal joint allows “universal pivotal movement,” with free and unobstructed movement in all directions. (Col. 3, line 2). But *Weiner* does not make any provision for control element(s) that are operable to position the device by incremental, independent rotation. In fact, a close study of *Weiner* reveals that there are no control elements operable to rotate the two structural support elements in either the horizontal or vertical planes (and certainly not to provide independent movement in each plane). Instead, the thumb screws (elements 31 and 32) operate to adjust the longitudinal distance between support elements (38 and 20) and to adjust the position of the “outrigger” (14) longitudinally along one of the support elements (20). The support elements (38 and 20) remain free to pivot in multiple directions via the universal joint; *Weiner* has no element that allows a doctor to incrementally control movement in each independent plane.

As *Weiner* does not disclose each and every element of claim 1, it cannot anticipate claim 1. Furthermore, since claims 3-5 are dependent on claim 1, *Weiner* cannot anticipate these claims either. Accordingly, Applicant requests that the Examiner withdraw the §102 rejection of claims 1 and 3-5 based on *Weiner* and instead recognize these claims as allowable.

III. OBVIOUSNESS REJECTION UNDER 35 U.S.C. §103

Examiner rejected claim 2 under 35 U.S.C. §103 as allegedly being obvious over *Pennig* (U.S. Patent No. 4,988,349) in light of *Squires* (U.S. Patent No. 5,524,859). Examiner alleges that *Pennig* “discloses the claimed invention except for the coupling assembly further comprising two worm gear assemblies,” and that “*Squires* discloses the

use of two worm gear assemblies.” Applicant has reviewed both of these references, and respectfully disagrees.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.” *MPEP* 706.02(j). And given the natural human tendency to view the world through the lens of hind-sight, extreme care must be taken when attempting an obviousness analysis. After all, “it is impermissible . . . to simply engage in hind-sight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant’s combination would have been obvious.” *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). With these guidelines in mind, *Pennig* and *Squires* cannot render claim 2 obvious.

First, as noted above, *Pennig* does not teach each and every element of the claim except for the use of two worm gear assemblies. Specifically, *Pennig* does not disclose control element(s), and certainly does not disclose control element(s) that allow incremental, independent rotation. A detailed argument on this point is set forth above, and hereby incorporated fully. Additionally, *Squires* does not seem to disclose two worm gear assemblies that allow rotation of a first portion and a second portion relative to each other in generally vertical and horizontal planes. While *Squires* does include a worm gear, the specifics regarding the worm gear do not match the requirements of claim 2. The worm gear of *Squires* does not provide rotational movement; instead, the worm gear of *Squires* appears to provide longitudinal movement of the housing for audio equipment in and out of the dashboard of a motor vehicle (so that the audio equipment can be securely stored in the dashboard when the car is turned off). Since *Pennig* and *Squires*

viewed together do not even include each and every element of claim 2 of the present application, claim 2 cannot be made obvious in light of their disclosure.

Furthermore, Applicant feels that it would be improper to combine these two references in an attempt to demonstrate obviousness. As the Examiner knows, multiple references can only be combined to establish obviousness if there is some teaching, suggestions, or motivation for combination. See *In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988). Here, there is no suggestion or motivation towards combination of these disparate references from disparate fields of technology. *Pennig* discloses an orthopedic medical device, while *Squires* discloses a security device for preventing theft of audio equipment from a motor vehicle. On its face, this is non-analogous art, which cannot properly be combined. Persons skilled in the orthopedic fixation device art field would not be inspired to seek out worm gear assembly elements for incremental, independent rotation of a medical device by consulting a reference so far afield as the stereo security dashboard device of *Squires*. Unfortunately, this appears to be an instance of impermissible hind-sight analysis. These two references cannot properly be combined in an attempt to find claim 2 obvious.

As *Pennig* and *Squires* do not disclose each and every element of claim 1, and as *Pennig* and *Squires* cannot be combined without the use of improper hind-sight analysis, these references cannot obviate claim 2. Accordingly, Applicant requests that the Examiner withdraw the §103 rejection of claim 2 and instead recognize this claim as allowable.

IV. ALLOWABLE SUBJECT MATTER

Applicant notes with appreciation the Examiner's statement that claims 8-10 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112. Applicant has overcome the indefiniteness objection by amending claim 1 above. Accordingly, Claims 8-10 should now be in condition for allowance.

CONCLUSION

The Applicant acknowledges the Examiner's remarks regarding the allowability of claims 8-10. Applicant further respectfully submits that as amended, pending claims 1-7 are also in condition for allowance. Accordingly, Applicant respectfully requests a Notice of Allowance for pending claims 1-10 in the present application. The Examiner is invited to contact the undersigned attorney if such would expedite the prosecution of the present application. The three-month response deadline is set to expire September 22, 2006. As a result, no extension fee is believed due with this filing. The Office is authorized to charge any necessary fees, however, to Deposit Account No. 13-0480, referencing the application serial number specified herein.

Respectfully submitted,

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